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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/802,401	03/17/2004	Achim Hartlaub	82448	3701

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EXAMINER

LUONG, VINH

ART UNIT	PAPER NUMBER
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3682

DATE MAILED: 04/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/802,401	HARTLAUB ET AL.	
	Examiner	Art Unit	
	Vinh T Luong	3682	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 7 and 8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 9-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.


Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


Vinh T. Luong
Primary Examiner

Attachment(s)

- | | |
|---------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/8/05</u> . | 6) <input checked="" type="checkbox"/> Other: <u>Attachment</u> . |

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1. Applicant's election of the species of Figs. 1-3 in the reply filed on April 8, 2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse. MPEP § 818.03(a).

2. Claims 7 and 8 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on April 8, 2005.

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

4. The abstract of the disclosure is objected to because the abstract uses implied phrase such as "[t]he invention relates to" and "[a]ccording to the invention." Correction is required. See MPEP § 608.01(b).

5. The drawings are objected to because:

(a) The sectional line, *e.g.*, A-A in Fig. 1 should have been changed to line 2-2 in order to correspond to Fig. 2;

(b) The drawing symbols for materials in cross-sectional views in Figs. 2-5 are improper. See drawing symbols in MPEP 608.02(o);

(c) The drawings fail to comply with 37 CFR 1.84 as seen in Form PTO-948 attached; and

(d) Each part of the invention such as the device and the steering wheel skeleton in claim 1 should be designated by a referential numeral or character.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

6. The disclosure is objected to because of the following informalities:

(a) In the brief description of the drawings, the sectional line, *e.g.*, A-A in Fig. 1 should have been changed to line 2-2 in order to correspond to Fig. 2;

(b) Each part of the invention such as: (1) the device and the steering wheel skeleton in claim 1; and (2) the region in claim 6 should be designated by a referential numeral or character; and

(c) The specification is inconsistent with the drawings or *vice versa*. For example, the specification describes the foam surround 4, however, Figs. 2-5 do not show that the element 4 is made of foam material in accordance with drawing symbols in MPEP 608.02(o).

Appropriate correction is required.

7. Claims 6, 12, and 13 are objected to because of the following informalities: no antecedent basis is seen for the terms such as “the region” in claim 6 and “the first build-on part” in claim 12. Appropriate correction is required.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-6 and 9-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear:

(a) which structural elements define the claimed elements such as the at least one device and the steering wheel skeleton in claim 1. Applicant is respectfully urged to identify each claimed element with reference to the drawings; and

(b) whether a confusing variety of terms such as “build-on parts” and “at least one build-on part” in claim 1 refer to the same or different things. See MPEP 608.01(o) and

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2173.05(o). Applicant is respectfully urged to identify each claimed element with reference to the drawings.

The recitation such as “*can be* fastened” in claim 12 is vague and indefinite in the sense that things which may be done are not required to be done, *e.g.*, the built-on parts can be, but is not required structurally to be fastened to an adaptor. See “*crimpable*” and “*discardable*” in *Mathis v. Hydro Air Industries*, 1 USPQ2d 1513, 1527 (D.C. Calif. 1986), “*removable*” in *In re Burke Inc.*, 22 USPQ2d 1368, 1372 (D.C. Calif. 1992), and “*comparable*” in *Ex parte Anderson*, 21 USPQ2d 1241, 1249 (Bd. Pat. App. & Inter. 1992).

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1-6 and 9-15, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Koide (USP 6,079,736 cited by Applicant).

Regarding claim 1, Koide teaches a steering wheel 10 with at least one device 32 for fastening of build-on parts 36, 38, 40, the steering wheel having a steering wheel skeleton (comprising a rim 14 and a spoke 18) surrounded by foam 14A, 42, wherein the device provided for the fastening of build-on parts 36, 38, 40 is, on the steering wheel skeleton 14, 18, a holding part 44, 32 (Fig. 1) which is fixed by the steering wheel foam surround 14A, 42 and which projects out (at 32A in Fig. 2 as seen in the Attachment) of the steering wheel foam surround 14A, 42 for fastening of at least one build-on part 36, 38, 40.

Regarding claim 2, the holding part 44, 32 bears against the steering wheel skeleton (along 44A in Fig. 2).

Regarding claim 3, the holding part 44, 32 is adhesively bonded to the steering wheel skeleton (14, 18). See col. 5, lines 30-36. On the other hand, it is well settled that the patentability of a product does not depend on its method of production. *In re Thorpe*, 227 USPQ 964, 966 (CAFC 1985); *In re Brown*, 173 USPQ 685 (CCPA 1972); *In re Fessmann*, 180 USPQ 324 (CCPA 1974); *Ex parte Edwards*, 231 USPQ 981 (BPAI 1986); and MPEP 2113.

Regarding claim 4, an interspace (Att.), which is filled by the steering wheel foam surround 14, 42, is present between the steering wheel skeleton (14, 18) and the holding part 44, 32.

Regarding claim 5, the holding part 44, 32 surrounds the steering wheel skeleton (14, 18) at least partially at one point (along 44A, Fig. 2).

Regarding claim 6, the holding part 44, 32 has a U-shaped design (defined by 44A, 44, and 32A in Fig. 2) in the region of the steering wheel skeleton (14, 18).

Regarding claim 9, the holding part 44, 32 is provided on a spoke 18 of the steering wheel 10.

Regarding claims 10 and 11, the holding part 44, 32 is a sheet metal or plastic part (synthetic resin or the like). *Id.*, col. 3, lines 26-34.

Regarding claim 12, the build-on parts 36, 38, 40 can be fastened to an adaptor 16 (Fig. 1, as the first build-on part, which is connected to the holding part 44, 32.

Regarding claim 13, the adaptor 16 is an adaptor plate.

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Regarding claim 14, the holding part 44, 32 is connected to the build-on parts 36, 38, 40 by means of screws or rivets. *Id.*, col. 3, lines 23-34.

Regarding claim 15, that portion (44 and unnumbered in Fig. 2 as seen in Att.) of the holding part 44, 32 which lies within the steering wheel foam 14A, 42 surround has a smaller longitudinal extent than the portion 32A, 32B which lies outside the steering wheel foam surround 14A, 42.

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. Claim 1, as best understood, is rejected under 35 U.S.C. 102(e) as being anticipated by Schutz (Pub. No.: US 2002/0124682 A1 filed on February 26, 2002).

Schutz teaches a steering wheel with at least one device 32, 42, 41 for fastening of build on parts 16, 18, etc., the steering wheel having a steering wheel skeleton 10 surrounded by foam 12, wherein the device 32, 42, 41 provided for the fastening of build-on parts 16, 18 is, on the steering wheel skeleton 10, a holding part 32 (Fig. 1) which is fixed by the steering wheel foam surround 12 and which projects out of the steering wheel foam surround 12 for fastening of at least one build-on part 16, 18, etc.

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14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Yamamoto et al. (Figs. 1-10), Bohn et al. (holding part 10, 26), Becker (holding part 4), Bathon et al. (holding part 5), and Kellogg et al. (holding part 6A).


15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vinh T. Luong whose telephone number is 571-272-7109. The examiner can normally be reached on Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bucci can be reached on 571-272-7099. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Luong

April 25, 2005


Vinh T. Luong
Primary Examiner

ATTACHMENT

FIG. 2

